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Robert Kronenberger

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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER

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EXAMINER

SUTTON, ANDREW W

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT KRONENBERGER

Appeal 2009-002843
Application 10/721,135
Technology Center 3700

Decided: October 19, 2009

Before DONALD E. ADAMS, DEMETRA J. MILLS, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1-3 and 5-21, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a headwear piece. Claim 1 is illustrative:

1. A headwear piece comprising:
 - a crown comprising an exposed external surface having a front, a rear, a right side, and a left side,
 - the crown further comprising a surface for embracing a wearer's head to maintain the headwear piece in an operative position on the wearer's head,
 - the crown having a) a front/right side octant; b) a right side/front octant; c) a right side/rear octant; d) a rear/right side octant; e) a front/left side octant; f) a left side/front octant; g) a left side rear octant; and h) a rear/left side octant;
 - a brim/bill projecting forwardly from the crown,
 - there being no brim/projecting from the crown from the left or right side of the crown so that the crown and brim/bill cooperatively are configured as a conventional baseball-style cap,
 - first information identifying an event on at least one of the front/left side and front/right side octants; and
 - second information identifying a plurality of participants in the event on at least one of a) the right side/front octant; b) the right side/rear octant; c) the rear/right side octant; d) the left side/front octant; e) the left side/rear octant; and f) the rear/left side octant.

The Examiner relies on the following evidence:

Armstrong	US 5,584,076	Dec. 17, 1996
Loeffelholz	US 6,175,963 B1	Jan. 23, 2001
Kronenberger	US 6,370,696 B1	Apr. 16, 2002
Park	US 6,408,443 B1	Jun. 25, 2002

The rejections presented by the Examiner are as follows:

1. Claims 1-3, 5-9, and 11-18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz and Kronenberger.
2. Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz, Kronenberger, and Park.

3. Claims 19-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz, Kronenberger, and Armstrong.

We affirm.

PRINCIPLES OF LAW

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). On appeal to this Board, Appellants must show that the Examiner has not sustained the required burden. *See Ex parte Yamaguchi*, 88 USPQ2d 1606, 1608 and 1614 (BPAI 2008) (precedential).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

With regard to printed matter, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983).

In *Gulack*, the claims recited “three key elements: (1) a band, ring, or set of concentric rings; (2) a plurality of individual digits imprinted on the band or ring at regularly spaced intervals; and (3) an *algorithm* by which the appropriate digits are developed.” *Id.* at 1382. With the digits generated by the algorithm printed on it, the band could be used “to perform magic tricks or to display various aspects of number theory.” *Id.* at 1383. Therefore, the *Gulack* court held that a new and unobvious functional relationship was established, wherein the looped structure of the substrate and the particular

digits printed on it interrelated to give the claimed product a property it would not have had if either the structure or the digits were changed. Therefore, the content of the printed matter was held to produce a nonobvious difference between the claimed product and the prior art.

In *In re Miller*, 418 F.2d 1392 (CCPA 1969), the claims at issue were drawn to measuring receptacles “adapted to ameliorate the mental strain on cooks.” *Id.* at 1394. Claim 10 of the application was illustrative, and was drawn to:

A measuring device comprising: a spoon for measuring ingredients; and volume measuring indicia defined in a normal volumetric unit on said spoon of a selected ratio to but indicating a volume different from the actual volume of ingredients being added to and measured in said spoon by said indicia, and a legend attached to said spoon specifying said ratio.

Id. at 1395.

The claimed measuring device contemplated not only measuring multiple recipes, but also solved “the greater difficulty of measuring out fractional recipes, such as $1/3$ or $1/2$.” *Id.* at 1393. The *Miller* court found that there was a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio. *Id.* at 1396.

In contrast, in *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), a printed matter limitation was held to be nonfunctional, and, therefore, inadequate to distinguish the claimed product from the prior art. Ngai claimed a kit that contained at least one of several reagents (e.g., buffer) and instructions that described a process of using the reagents to amplify RNA. *Id.* at 1337. The *Ngai* court held that the printed instructions were not related to the claimed

kit in the way that Gulack's numbers were related to his band. According to the *Ngai* court,

In *Gulack*, the printed matter would not achieve its educational purposes without the band, and the band without the printed matter would similarly be unable to produce the desired result. Here, the printed matter in no way depends on the kit, and the kit does not depend on the printed matter. All that the printed matter does is teach a new use for an existing product."

Id. at 1339.

Obviousness:

The combination of Loeffelholz and Kronenberger:

ISSUE

Has Appellant established a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece)?

FINDINGS OF FACT

FF 1. Appellant does not dispute that the combination of Loeffelholz and Kronenberger teaches a headwear piece (e.g., a hat) within the scope of Appellant's claimed invention (*see e.g.*, Ans. 4 and App. Br. 4-5).

FF 2. The Examiner finds that Kronenberger discloses a cap with "various designs that include school, object, information, team, email, etc. at various points around the cap" (Ans. 4).

ANALYSIS

Appellant contends that “[t]he last two limitations in claim 1 are what distinguish the invention from a conventional-style baseball cap, standing alone” (App. Br. 4). These limitations define the location and type of information displayed on the cap. Appellant contends “that the two specific types of ‘information’ and their strategic placement, amount to more than mere ornamentation and present structural limitations that patentably distinguish over the cited art” (App. Br. 5). In this regard, Appellant contends that “the significance of Appellant’s claimed subject matter relates to the specific type of information and its viewability from different perspectives which allows the headwear piece to function uniquely compared to other headwear pieces” (App. Br. 6). Specifically, Appellant contends that:

From a front perspective, the identity of the event is prominent, making it useable by the participants; as during a competitive baseball game. From other perspectives, the participants in the event can be identified, making the headwear piece valuable to a fan or souvenir seeker as a memento from the event that identifies participants.

(*Id.*) We are not persuaded.

The difference between the prior art and the claimed invention is simply the arrangement of nonfunctional descriptive material describing a particular event and the participants in the event. Notwithstanding Appellant’s contentions to the contrary, these descriptive materials are not functionally related to the headwear piece as in *Miller* (*Cf.* App. Br. 6).

In *Miller* there was a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio.

Miller, 418 F.2d at 1396. Here, the cap is simply a substrate, a poster board, upon which the descriptive material is placed. The descriptive material of the instant invention has no functional relationship with the cap. The cap will function without the descriptive material and the descriptive material would achieve its purpose if attached, for example, to a box. Appellant concedes that the descriptive material is ancillary to the cap and serves only to provide notice of the event and the participants in the event to which the cap may be worn (*see e.g.*, App. Br. 6; *see also* Reply Br. 2-3). Similarly, the instant invention is distinct from Gulack's hat band wherein the looped structure of the substrate and the particular digits printed on it interrelated to give the claimed product a property it would not have had if either the structure or the digits were changed.

We recognize each of Appellant's separate arguments regarding claims 2, 3, 5-9, and 11-18 (App. Br. 7-10). Each of these separate arguments relate to the location of the non-functional descriptive material on the cap. In sum, we are not persuaded by these arguments for the reasons set forth above.

CONCLUSION OF LAW

Appellant failed to establish a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece).

The rejection of claims 1-3, 5-9, and 11-18 under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz and Kronenberger is affirmed.

The combination of Loeffelholz, Kronenberger, and Park:

ISSUE

Has Appellant established a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece)?

FINDINGS OF FACT

FF 3. The Examiner relies on the combination of Loeffelholz and Kronenberger as discussed above (Ans. 5).

FF 4. The Examiner relies on Park to teach “that hats including logos . . . can have an opening . . . in the crown area” (*id.*). Appellant concedes that this is a known construction (App. Br. 8).

ANALYSIS

Appellant contends that the prior art fails to teach a headwear piece “with the information applied as recited in claim 1, from which” claim 10 depends (App. Br. 8). We are not persuaded for the reasons set forth above.

CONCLUSION OF LAW

Appellant failed to establish a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece).

The rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz, Kronenberger, and Park is affirmed.

The combination of Loeffelholz, Kronenberger, and Armstrong:

ISSUE

Has Appellant established a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece)?

FINDINGS OF FACT

FF 5. The Examiner relies on the combination of Loeffelholz and Kronenberger as discussed above (Ans. 5).

FF 6. The Examiner relies on Armstrong to teach “an opening in the back of the hat with an adjustable strap . . . located across the opening” (Ans. 5-6).

FF 7. Appellant concedes that “[t]he structure in claims 19-21, by itself, is known in the prior art” (App. Br. 10).

ANALYSIS

Appellant contends that the prior art fails to teach a headwear piece with the information applied as recited in claim 1, from which these claims depend (App. Br. 10). We are not persuaded for the reasons set forth above.

CONCLUSION OF LAW

Appellant failed to establish that a new and unobvious functional relationship between the printed matter (i.e., the first and/or second information) and the substrate (i.e., the headwear piece).

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The rejection of claims 19-21 under 35 U.S.C. § 103(a) as unpatentable over the combination of Loeffelholz, Kronenberger, and Armstrong is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

lp

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